

REMARKS

[0001] The Examiner objected to two sections of text within the specification due to informalities. The Examiner objected to claims 15-17, and 19 but notes that these claims would be allowable if rewritten in independent form. The Examiner rejected the traversal of the restriction requirement submitted by the Applicant. The Examiner rejected Claims 11, 13, 14, and 18 under 35 U.S.C. §102(b) as anticipated by Japanese Patent JP4-221474A to Ogawa et al. (hereinafter "Ogawa"). The Examiner rejected Claim 12 under 35 U.S.C. §103(a) as being unpatentable over Ogawa in view of journal article "Micromachining on (111)-Oriented Silicon" from Sensors and Actuators 75 (1999) 271-277 by Chou et al. (hereinafter "Chou").

[0002] The claims have been amended to address the rejection of claims 11, 13, 14, and 18 and to address the rejection of the traversal of the restriction requirement. The specification has not been amended to address the objections to the specification due to inconsistent information. For reasons set forth below, Applicant respectfully requests that the rejections be withdrawn and that claims 1-24 be allowed.

OBJECTIONS TO THE SPECIFICATION

[0003] The Examiner objected to a section of the specification from line 28 of page 1 to line 2 of page 2. The original application submitted by the Applicant numbered each line of the specification in the left margin of the page. However, the line numbers on page 1 conclude with line 26. Consequently, there is not a line 28 on page 1. The Application respectfully requests that the Examiner more specifically describe the objectionable text and provide a reason for the objection.

[0004] The Examiner objected to page 22 of the specification. However, page 22 of the original application submitted by the Applicant contains Claims 14-19, which are currently pending. Consequently, the Applicant suspects the Examiner may have intended to refer to a section of the specification other than page 22. The Application respectfully requests that the

Examiner more specifically describe the objectionable text and provide a reason for the objection.

REJECTION OF CLAIM 11 UNDER 35 U.S.C. §102(b)

[0005] The Examiner rejected claims 11, 13, 14, and 18 under 35 USC §102(b) in view of Ogawa. Applicant has amended Claims 1, 5, 11, 12, 14, and 20 to further clarify the invention.

[0006] Specifically, claim 11, as amended, specifies “a movable member *integrally* coupled with the read/write slider” *See* amended claim 11. As described in the specification, the movable member is integrally coupled to the slider. The integral coupling is supported by the fact that movable member is formed from the same block of material as the slider by etching away a portion of the slider. *See* lines 10-12 of page 10, and lines 1-6 of page 14 of the specification. The movable member is permanently attached to the slider without the aid of a fastening or securing mechanism. Applicant has amended Claims 1, 5, 14, and 20 to further clarify the invention by reflecting the integral coupling of the movable member to the read/write slider. Additionally, Claim 12 has been amended to clarify the invention by specifying that the movable member comprises a generally accepted reactive ion etchable material.

[0007] Ogawa discloses a head supporting spring mechanism, which could also be called a movable member, that is not integrally coupled to a head. Rather, the head supporting spring mechanism is attached to the head using some type of connecting member such as glue, rivets, screws, or the like. Ogawa does not disclose a head supporting spring mechanism formed from the same piece of material as the head. Consequently, the head supporting spring mechanism disclosed by Ogawa is coupled, but not *integrally coupled* to the head.

[0008] It is well settled that under 35 U.S.C. §102 that “an invention is anticipated if . . . all the claim limitations [are] shown in a single art prior art reference. Every element of the

claimed invention must be literally present, arranged as in the claim. The identical invention must be shown in as complete detail as is contained in the patent claim.” *Richardson v. Suzuki Motor Co., Ltd.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Therefore, only if each limitation is literally disclosed by the prior art reference is the claim anticipated.

[0009] Applicant respectfully asserts that Ogawa fails to identically show each element in amended independent Claim 11. Namely, Ogawa fails to teach “a movable member *integrally* coupled with the read/write slider.” Therefore, every element of the claimed invention is not literally present, arranged as in the claim. *Richardson v. Suzuki Motor Co., Ltd.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). The identical invention is not shown in as complete detail as is contained in the patent claim. *Id.* Applicant respectfully submits that independent Claim 11 is patentably distinct from Ogawa.

[0010] The Examiner rejected claims 13, 14, and 18 under 35 USC §102(b) in view of Ogawa. However, since Claims 13, 14, and 18 depend from amended Claim 11, the Applicant respectfully submits that Claims 13, 14, and 18 are also patentably distinct from Ogawa.

REJECTION OF CLAIMS 12 UNDER 35 U.S.C. §103(a)

[0011] The Examiner rejected claim 12 under 35 USC §103(a) in view of Ogawa and Chou. Applicant has amended Claim 11 from with Claim 12 depends to further clarify the invention as discussed above.

[0012] The Examiner bears the initial burden of establishing a *prima facie* case of obviousness. *See* MPEP § 2142. To establish a *prima facie* case of obviousness, the combination of the prior art references must teach or suggest all the claim limitations. MPEP § 2142.

[0013] Applicants respectfully assert that the combination of Ogawa and Chou fails to teach or suggest all the claim limitations of amended independent Claim 11 from which Claim 12

depends. Specifically, Ogawa fails to teach or disclose “a movable member *integrally* coupled with the read/write slider.” Accordingly, Applicant respectfully asserts that claims 12 is allowable in view of amended Claim 11 because neither Ogawa nor Chou teach or disclose the missing elements of amended Claim 11.

REJECTION OF CLAIMS 1-10 AND 20-24

[0014] The Examiner rejected the Applicant’s traversal of the requirement for election of claims. The Applicant has modified Claim 15 to clarify the invention. Amended Claim 15 states in relevant part, “the movable member further comprises a *lithographically defined* tongue-shaped region etched out of a face of a body of the read/write slider.” As described in lines 10-12 of page 9 of the specification, an etched region of the slider forms the movable member.

[0015] A pre-requisite to etching a region of silicon is to lithographically define the region to be etched. The region to be etched is lithographically defined by depositing a photoresist material over those portions of the slider that should not be etched. Those regions of the slider that are to be etched do not have photoresist material deposited over them. Lithographically defining the portions of the slider that will and will not have photoresist material deposited is accomplished in the described embodiments using a standard procedure involving a mask and a light source. This process of lithographically defining regions of the silicon to be etched is well understood by those of skill in the art. The method of lithographically defining the etched region that forms the movable member is further described on pages 11-3 of the specification. Lithographically defining, and then etching the slider to form the movable member ensures that the movable member is integrally coupled to the slider. In fact, the Applicant knows of no other way to form the moveable member so that the movable member is integrally coupled to the slider other than lithographically defining the movable member and etching the slider to form the movable member.

[0016] The process described in the claims of Group I includes lithographically defining the movable member. The product described by the claims of Group II, specifically amended Claim 15 is also lithographically defined. In view of amended Claim 15, Groups I and II are not

distinct since the product as claimed (by the claims of Group II) cannot be made, in any manner currently known, by a materially different process from the process of the claims of Group I. Additionally, independent Claim 1, which describes a process for making an apparatus, and independent Claim 11, which describes the apparatus itself, recite substantially the same elements. Therefore, the Applicant respectfully submits that Group I and Group II cannot be distinct.

[0017] The Examiner asserts that groups I and III are unrelated. However, Applicant asserts that Groups I and III are related because Groups I, II and II are related as a method of making a product, the product, and a process of using the product under MPEP §806.05(i). Groups I and II are related as a product and method of making the product that are not distinct under MPEP §806.05(f) as explained above. Groups II and III are related as a product and a process of using under MPEP §806.05(h). Due to this, no restriction is proper for any of the three groups of claims.

[0018] MPEP §806.05(i) recites:

Where the product claims are allowable (i.e., novel and nonobvious), restriction may be required *only where the process of making and the product made are distinct* (MPEP § 806.05(f)); otherwise, the process of using must be joined with the process of making and product made, even if a showing of distinctness can be made between the product and process of using (MPEP § 806.05(h)). *Italics added.*

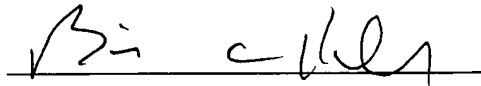
[0019] In view of the discussion above regarding the 35 USC §102(b) and 35 USC §103(a) rejections of claims within Group II, the amended claims of Group II should now be allowable. In view of the discussion above, the process of making, Group I, and the product made, Group II, are not distinct, as explained above. Therefore, a restriction requirement is improper because “the process of using must be joined with the process of making and product made, even if a showing of distinctness can be made between the product and process of using.” MPEP §806.05(i).

[0020] Therefore, in view of the remarks above, Applicant respectfully asserts that restriction of claims 1-24 into Groups I, II, and III is improper. Applicant respectfully traverses

the Examiner's rejection of earlier traversal and requests that the restriction requirement be withdrawn.

[0021] In view of the foregoing, Applicants submit that the application is in condition for allowance. In the event any questions or issues remain that can be resolved with a phone call, the Examiner is respectfully requested to initiate a telephone conference with the undersigned.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Brian C. Kunzler', is written over a horizontal line.

Brian C. Kunzler
Reg. No. 38,527
Attorney for Applicant

Date: July 8, 2004
8 East Broadway, Suite 600
Salt Lake City, UT 84111
Telephone (801) 994-4646
Fax (801) 322-1054